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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/912,427	07/26/2001	Bradford H. Needham	P 279172 P11167	4273

27496 7590 05/16/2005

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EXAMINER
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LEZAK, ARRIENNE M

ART UNIT	PAPER NUMBER
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2143

DATE MAILED: 05/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/912,427

Applicant(s)

NEEDHAM ET AL.

Examiner

Arrienne M. Lezak

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## DETAILED ACTION

Examiner notes that Claims 1, 11 & 19 have been amended, no Claims have been cancelled and no Claims have been added. Claims not explicitly addressed herein are found to be addressed within prior Office Action dated 10 November 2004 as reiterated herein below.

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over extensive consideration of US Patent 5,760,917 to Sheridan in view of US Patent US 6,611,613 B1 to Kang.

3. Regarding Amended Claims 1, 11, 19, and Original Claims 29 & 31, Sheridan discloses a method, system and computer program for image sharing, (Abstract), comprising:

- defining a sharing rule that specifies with which one or more recipients images are shared, the sharing rule based on identifying information, (Col. 5, lines 7-18); and

- applying identifying information associated with the image to the sharing rule to determine the one or more recipients with which the image should be shared, (Col. 5, lines 19-42; Col. 10, lines 61-67 & Col. 11, lines 1-59), making the same available to said recipients, (Col. 4, lines 25-67 & Col. 5, lines 1-45).

4. Though Sheridan discloses indexing and sharing digital images associated with identification information entered by the user, Sheridan does not specifically enumerate the use of face recognition technology. Kang discloses face recognition technology, which technology obviously includes means for analysis of image to determine face and association of face identification information to the image corresponding to the determined face. It would have been obvious to one of ordinary skill in the art at the time of invention by Applicant to incorporate the use of face recognition technology into the Sheridan image distribution method and system as noted within Kang, which enumerates the fact that image indexing is one field, which highly regards face recognition technology, (Col. 1, lines 26-30). Thus, Amended Claims 1, 11, 19, and Original Claims 29 & 31 are found to be unpatentable in light of the combined teachings of Sheridan in view of Kang.

5. Regarding Claims 2, 6, 12, 16, 20 & 24, Sheridan in view of Kang discloses a method, system and computer program for image sharing, further comprising: determining the (face) identifying information/data associated with the image using a (face) recognition/conversion technique, (Sheridan - Col. 5, lines 7-45), in conjunction with a database of (face) information, (Sheridan - Abstract; Col. 2, lines 20-67; Col. 3,

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lines 1-15; Col. 4, lines 25-61; Col. 10, lines 61-67; & Col. 11, lines 1-59). Examiner notes that indexing digital image information using face recognition technology obviously reads upon identification information stored in a database of image information. Thus, Claims 2, 6, 12, 16, 20 & 24 are found to be unpatentable in light of the combined teachings of Sheridan in view of Kang.

6. Regarding Claims 3, 13 & 21, Sheridan in view of Kang discloses a method, system and computer program for image sharing, further comprising: determining the (face) identifying information associated with the image by a user identifying a (face) in the image, (Sheridan - Col. 5, lines 34-42). Thus, Claims 3, 13 & 21 are found to be unpatentable in light of the combined teachings of Sheridan in view of Kang.

7. Regarding Claims 4, 14 & 22, Sheridan in view of Kang discloses a method, system and computer program for image sharing, further comprising: automatically making the image available to the determined one or more recipients, (Sheridan - Col. 5, lines 7-64). Thus, Claims 4, 14 & 22 are found to be unpatentable in light of the combined teachings of Sheridan in view of Kang.

8. Regarding Claims 5, 15 & 23, Sheridan in view of Kang discloses a method, system and computer program for image sharing wherein making the image available comprises at least one of automatically sending a copy of the image to the determined one or more recipients by email and automatically sending a link to the image on a Web site to the determined one or more recipients, (Sheridan - Col. 5, lines 7-64). Thus, Claims 5, 15 & 23 are found to be unpatentable in light of the combined teachings of Sheridan in view of Kang.

9. Regarding Claims 7, 17, 25, 30 & 32, Sheridan in view of Kang discloses a method, system and computer program for image sharing wherein the image comprises at least one of a digital photo and a digital video, (Sheridan - Col. 4, lines 3-47).

Examiner notes that digital video would be obvious in light of the teaching of digital images generally as a digital video is comprised of a series of digital images. Thus, Claims 7, 17, 25, 30 & 32 are found to be unpatentable in light of the combined teachings of Sheridan in view of Kang.

10. Regarding Claims 8, 18 & 26, Sheridan in view of Kang discloses a method, system and computer program for image sharing wherein the sharing rule specifies at least one of a set of (face) identifying information, a range of (face) identifying information and a characteristics of an item or set of (face) identifying information, (Sheridan - Col. 10, lines 30-67 & Col. 11, lines 1-22). Thus, Claims 8, 18 & 26 are found to be unpatentable in light of the combined teachings of Sheridan in view of Kang.

11. Regarding Claims 9 & 27, Sheridan in view of Kang discloses a method, system and computer program for image sharing wherein the sharing rule comprises a rule that images are only to be shared with the one or more recipients that are on a (buddy) list, (Sheridan - Col. 4, lines 48-67; Col. 5; and Col. 6, lines 1-24). Examiner notes that Sheridan teaches a stored list of individuals with whom the user has chosen to share images. Further, said list would obviously include friends or "buddies" of the user, and as such, could obviously be referred to as a "buddy list". Thus, Claims 9 & 27 are found to be unpatentable in light of the combined teachings of Sheridan in view of Kang.

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12. Regarding Claims 10 & 28, Sheridan discloses a method, system and computer program for image sharing wherein the (face) identifying information (comprises a personal name of a person whose face) is in the image, (Sheridan - Col. 10, lines 30-67 & Col. 11, lines 1-22). Examiner notes that the use of personal names corresponding to individuals within the photos would have been obvious in light of the indexing/storage functionality within Sheridan wherein the user chooses individuals by name with whom particular images will be shared. Thus, Claims 10 & 28 are found to be unpatentable in light of the combined teachings of Sheridan in view of Kang.

### ***Response to Arguments***

13. Applicant's arguments filed 10 February 2005, have been fully considered but they are not persuasive. Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

14. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re*

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*Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, as clearly noted above, Kang provides proper motivation to combine the references by clearly noting, “a technique for detecting faces and facial area is highly regarded in various applied fields such as...image indexing,” (Kang – Col. 1, lines 17-32), which image indexing is clearly taught by Sheridan as noted herein.

15. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Specifically, Applicant argues that the prior art does not suggest the use of face identifying information as applied to a sharing rule to determine which recipients should receive the image. As noted herein above, the combination of the references clearly reads upon Applicant's claim language in it's entity, (and as amended), as Sheridan clearly teaches an (image) sharing rule and Kang clearly teaches face recognition technology in addition to the motivation to combine. Moreover, Examiner notes that proof of enablement is not a requirement under 35 USC § 103(a); however, Examiner further notes the fact that both Sheridan and Kang have been patented, proving enablement of the same, such that one of ordinary skill in the art would know how to enable the combination of the two references.

16. Thus, as Examiner has completely addressed Applicant's amendment, and finding Applicant's arguments do not show how the amendments and reconsideration of



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the same avoids such references or objections, Examiner hereby maintains the rejection of all original and amended claims in their entirety.

***Conclusion***

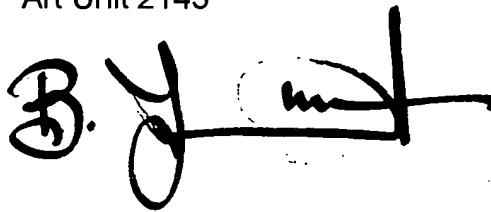
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arrienne M. Lezak whose telephone number is (571)-272-3916. The examiner can normally be reached on M-F 8:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on (571)-272-3923. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AML

Arrienne M. Lezak  
Examiner  
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A handwritten signature in black ink, appearing to read 'B. Jaroenchonwanit', with a large, stylized flourish extending from the end.

**BUNJOB JAROENCHONWANIT  
PRIMARY EXAMINER**